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| EXAMINER |
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3764

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Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 17

Application Number: 09/765,533
Filing Date: January 19, 2001
Appellant(s): HOWLETT-CAMPANELLA, HELEN HARDMAN

Scott W. Kelley
For Appellant

EXAMINER'S ANSWER

MAILED
JAN 13 2004
GROUP 3700

This is in response to the appeal brief filed October 6, 2003.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The amendment after final rejection filed on 8/19/02 has been entered.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1-23 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,645,494

Dionne et al

7-1997

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

1. Claim 23 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the invention, at the time the application was filed, had possession of the claimed invention. The "plurality of markers 54, 56, and 58" is not supported by the original disclosure of the instant application nor are the markers supported in the related provisional applications.

Claims 1, 3-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dionne. As to claims 1, 4 and 11, Dionne discloses an mat (fig. 1) having an upper surface (24) and a lower surface (20) and a symmetrical body placement guide (30) on the upper surface of the mat; a patterned design (30; col. 3, lines 66-67 thru col. 4, line 1-22) defining a longitudinal axis (42) substantially extending the length of and bisecting the upper surface, the design defining a transverse axis (40) bisecting the longitudinal axis and indicia (31,32,33,34) *positioned* from the longitudinal axis (42) at 45 degree angles. As broadly as claimed, from any point on the longitudinal axis, a line can be at a 45 degree angle, where the indicia or grid pattern [of Dionne] is intercepted, thereby positioned at that 45 degree angle; four quadrants (col. 4, line 23) defined by the longitudinal and transverse axes where the quadrants are adjacent and are a mirror image of adjoining adjacent quadrants (figs. 1, 3a-4b and 6-8). In response to the

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argument that Dionne does not disclose the mat as being elongated. The Appellant should note that a change in the shape of a prior art device is a design consideration within the skill of the art. *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). It would have been obvious to one having ordinary skill in the art at the time the invention was made to design the mat of Dionne in an elongated shape in order to provide more area on the surface of the mat for the user to stand. In response to the argument that (30) of Dionne is not a body placement guide, The Examiner contends that the pattern of Dionne is a guide for foot placement (col. 4, lines 5-6), which are a part of the body. As to claims 3, 5, 12 and 19, the indicia (31-34) comprise a line(s) that *extends* from the longitudinal and transverse axis. However, a line extending at a 45-degree angle is not shown. In response to the argument that the lines are not extending from the longitudinal and transverse lines at a 45 degree angle, the applicant should note that absent a teaching as to criticality that the indicia extend from the longitudinal axis at a 45 degree angle, this particular arrangement is deemed to have been known by those skilled in the art since the instant specification and evidence of record fail to attribute any significance (novel or unexpected results) to a particular arrangement. *In re Kuhle*, 526 F.2d 553, 555, 188 USPQ 7, 9 (CCPA 1975). As to claims 6-9, 13-16 and 20-22, Dionne discloses the design having multiple segments of equal areas parallel to the transverse and longitudinal axis (col. 4, lines 14-67) to include indicia for step (36 and col. 4, lines 58-59) having intersecting lines that form ninety degree angles. As to claim 18, see the paragraph above for claims 1 and 8.

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As to claims 10 and 17, the mat has a rectangular configuration (fig. 8; col. 5, lines 53-55). In response to Appellant's arguments regarding the functional recitation of the device being a "yoga" mat and "configured to aid a yoga practitioner to properly align the practitioner's body during yoga postures," it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). As to claim 23, as best understood by the examiner, Dionne teaches a mat having a flat structure with an upper and lower surface and a longitudinal axis (see the paragraph for claim 1); a first center line (42) positioned upon the upper surface and a second center line (40) positioned upon the upper surface parallel to the longitudinal axis and orthogonal with respect to the first center line (fig. 8); a plurality of first lines (31,32) parallel to the first center line and a plurality of second lines (33,34) parallel to the second center line where the lines provide a plurality of squares on the mat (fig. 8); the rectangles are separated into four quadrants each having a center point (at a intersection of the lines); a plurality of markers(25) located on selected intersections of the second lines with the first line and at each center point of each of the quadrants. Dionne discloses all of the limitations of the claimed subject matter except for the lines providing a plurality of rectangle shapes on the mat and the rectangles being separated into six non-overlapping sets and the markers located in the center of the quadrant. Regarding the rectangle shape, the applicant should note that a change in the shape of a prior art device is a design consideration within the skill of the art. *In re Dailey*, 357 F.2d 669,

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149 USPQ 47 (CCPA 1966). Regarding the markers in the center, it would have been obvious to one having ordinary skill in the art at the time the invention was made to locate the tee locations of Dionne in the center of the quadrants, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

(11) Response to Argument

In response to the 112 Rejection: Appellant argues that the “plurality of markers” *is* disclosed in the provisional applications. The Examiner has **consistently** disagreed with this statement. The Examiner contends that the “markers” being referred are merely darkened points on the drawings that have occurred as a result of an intersection of multiple lines. There is no evidence in the specification or labeling in the drawings of the provisional(s) applications or the instant application to reference such elements as “markers.” The Examiner has consistently remarked that based upon the general definition of a mark, or marker, that there is no evidence in the disclosure to support the indicia Appellant claims as a “marker.” Finally, the term “marker” is considered an additional element. Furthermore, Appellant has attempted to include the limitations of the markers only after discovery of prior art not cited [Marquez U.S. 5,645,494] in an amendment filed after final rejection. Appellant acknowledges in the brief (page 15, line 19 and page 16, line 15) that the term marker had been “taken from Marquez” along with claim 23 in order to provoke an interference.

In response to the 103 Rejection: In response to Appellant’s argument that Dionne is not analogous art, it has been held that the determination that a reference is from a nonanalogous art is twofold. First, we decide if the reference is within the field of the inventor’s endeavor. If it is not, we proceed to determine whether the reference is reasonably pertinent to the particular problem with which the inventor was involved. *In re Wood*, 202 USPQ 171, 174. In this case, the Examiner contends that since both the instant application and the reference of record both claim a mat using indicia to define a

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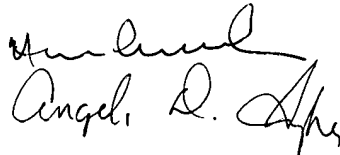
particular *use*, the structural limitations, as broadly as claimed, of the claimed invention are reasonably met by Dionne. In response to Appellant's argument that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. *In re McLaughlin*, 443 F.2d 1392 170 USPQ 209 (CCPA 1971). For the remaining discussion on arguments pertaining to the 103 rejections, see the Grounds of Rejection paragraphs above.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

L. Amerson
January 12, 2004

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